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10/813,423	03/30/2004	John J. Connors III	8627-452	4776

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EXAMINER	
SELLMAN, CACHET I	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN J. CONNORS III, KURT J. TEKULVE,
and THOMAS A. OSBORNE

Appeal 2009-2200
Application 10/813,423
Technology Center 1700

Decided:[1] April 29, 2009

Before EDWARD C. KIMLIN, ADRIENE LEPIANE HANLON, and CHUNG K. PAK, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is an appeal from the final rejection of claims 1-5. Claim 1 is illustrative:

1. A method for making a wire guide comprising:

providing a mandrel having a proximal portion and a distal portion;

applying a first coating having a low coefficient friction over the mandrel;

removing the first coating from the distal portion of the mandrel;

connecting a coil to the distal portion mandrel;

applying a second coating over the distal portion of the mandrel, wherein the second coating provides a sub-structure; and

applying a third coating over the second coating, wherein the third coating comprises a surface that allows for easy maneuverability of the wire guide.

The Examiner relies upon the following references in the rejection of the appealed claims:

Jafari	US 6,652,472 B2	Nov. 25, 2003
Engelson	EP 769306 A2	Apr. 23, 1997

Appellants' claimed invention is directed to method for making a wire guide. The method comprises, *inter alia*, providing a mandrel having proximal and distal portions, applying a first coating over the mandrel, and removing the first coating from the distal portion of the mandrel.

Appealed claims 1, 2, and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated over Engelson. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engelson in view of Jafari.

We have thoroughly reviewed the respective positions advanced by Appellants and the Examiner. In so doing, we find that the Examiner's rejections are not supported by the prior art evidence relied upon. Accordingly, we will not sustain the Examiner's rejections.

We consider first the § 102(b) rejection over Engelson. As acknowledged by the Examiner, Engelson does not describe coating the distal portion of a mandrel and then removing the coating from the distal portion. Engelson teaches coating only the more proximal region of the mandrel with a first coating. The Examiner's rejection, however, is based on rationale that Engelson's coating of the proximal region necessarily or inherently results in the coating also being applied to the distal region, and that the subsequent oxygen plasma treatment also necessarily or inherently removes the first coating that was incidentally provided on the distal portion. The Examiner reasons that since Engelson is silent with respect to masking the distal portion during the coating of the proximal portion, coating of the distal portion necessarily ensues. The Examiner makes the finding that "when a certain portion of an object is desired to be coated there are two ways in which this can be achieved (1) by masking off the area which is not intended to receive the coating or (2) by applying the coating then removing the coating from undesired portions" (Answer 8, second paragraph).

It is well settled that a determination of inherency can not be established by probabilities or possibilities, but it is incumbent upon the Examiner to establish the inevitability of the inherency based upon factual evidence or persuasive scientific reasoning. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 635-36 (CCPA 1976). In the present case, we must agree with Appellants that Engelson's silence with respect to masking the distal portion of the mandrel is not tantamount to the inevitable coating of the distal portion during coating of the proximal portion. For instance, the Examiner has not refuted Appellants' argument that Engelson's coating can be restricted to the proximal portion of the mandrel by spraying the material at a particular angle which avoids the distal portion of the mandrel. Furthermore, inasmuch as the Examiner acknowledges that it was known in the art to mask portions of a substrate that are not meant to receive a coating, it is just as reasonable to conclude that Engelson does not disclose the well known technique of masking the distal portion of the mandrel during coating only the proximal portion. Consequently, we find that the Examiner has not established the inevitability of Engelson's method performing an unintentional coating of the distal portion of the mandrel as well as the proximal portion.

Jafari, cited by the Examiner in combination with Engelson for the § 103 rejection of claim 3, does not remedy the deficiency of Engelson discussed above.

In conclusion, based on the foregoing, we are constrained to reverse the Examiner's rejections.

REVERSED

PL initial:
sld

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